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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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THE DIRECTV GROUP INC
PATENT DOCKET ADMINISTRATION RE/R11/A109
P O BOX 956
EL SEGUNDO, CA 90245-0956

EXAMINER

SHELEHEDA, JAMES R

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,241

Applicant(s)

COCCHI ET AL.

Examiner

James Sheleheda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 40-43, 48-52, 57-61 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano et al. (Nakano) (US 2002/0055847) (of record) in view of Hunter et al. (Hunter) (US 2002/0056118 A1) (of record).

As to claim 40, Nakano discloses a method for receiving subscriber information (Fig. 6) comprising:

(a) receiving, in a set top box (10, paragraph 27), broadcast signals (paragraph 22, lines 1-7) through a tuner of the set top box (wherein a tuner is inherently present to tune to a broadcast channel; paragraph 22, lines 4-7); and

(b) enabling a presentation device (television 12) connected to the set top box to display the broadcast signals (paragraph 22, lines 1-7);

(c) automatically connecting (the set top makes a connection when the card is entered; paragraph 34, lines 1-3) to the Internet (Fig. 5; paragraph 26, lines 1-8) using a communication module (a modem; paragraph 26, lines 5-8) of the set top box (paragraph 26, lines 5-8) without the user requesting the connection (wherein connection takes place upon entry of the card; paragraph 33, lines 6-12 and paragraph

34, lines 1-3), wherein the communication module is different the tuner (Fig. 1; paragraph 22).

While Nakano discloses receiving information from the Internet (for home shopping; paragraph 31, 36 and 37), he fails to specifically disclose receiving a subscriber renewal notice over the connection to the Internet.

In an analogous art, Hunter discloses a video distribution system (Fig. 4; paragraph 12) wherein a user will receive broadcast video for display on a television (paragraphs 65 and 70) and will automatically connect to the Internet through a modem (87, paragraph 51, lines 16-18 and 31-34 and paragraph 67) to receive monthly subscriber renewal notices (monthly renewed security codes to ensure a site is authorized to view the movie; paragraphs 79, 82 and 83) for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display videos (paragraph 79).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Nakano's system to include receiving a subscriber renewal notice over the connection to the Internet, as taught by Hunter, for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display the received content.

As to claim 49, Nakano discloses a system for receiving information (Fig. 6) comprising:

a set top box is configured to:

receive broadcast signals (paragraph 22, lines 1-7) through a tuner (wherein a tuner is inherently present to tune to a broadcast channel; paragraph 22, lines 4-7); and enable a presentation device (television 12) connected to the set top box (Fig. 1) to display the broadcast signals (paragraph 22, lines 1-7);

automatically connect (paragraph 34, lines 1-3) to the Internet (Fig. 5; paragraph 26, lines 1-8) using a communication module (a modem; paragraph 26, lines 5-8) of the set top box (paragraph 26, lines 5-8) without the user requesting the connection (paragraph 33, lines 6-12 and paragraph 34, lines 1-3), wherein the communication module is different than the tuner (Fig. 1; paragraph 22).

While Nakano discloses receiving information from the Internet (for home shopping; paragraph 31, 36 and 37), he fails to specifically disclose receiving a subscriber renewal notice over the connection to the Internet.

In an analogous art, Hunter discloses a video distribution system (Fig. 4; paragraph 12) wherein a user will receive broadcast video for display on a television (paragraphs 65 and 70) and will automatically connect to the Internet through a modem (87, paragraph 51, lines 16-18 and 31-34 and paragraph 67) to receive monthly subscriber renewal notices (monthly renewed security codes to ensure a site is authorized to view the movie; paragraphs 79, 82 and 83) for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display videos (paragraph 79).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Nakano's system to include receiving a subscriber

renewal notice over the connection to the Internet, as taught by Hunter, for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display the received content.

As to claim 58, Nakano discloses an article of manufacture for receiving information (Fig. 6) comprising:

means for a set top box (Fig. 1; 10) connectable to a presentation device (Fig. 1; 12) to receive broadcast signals (paragraph 22, lines 1-7) through a tuner (a tuner is inherently present to tune to a broadcast channel; paragraph 22, lines 4-7);

means for the set top box (10) to enable the presentation device (television, 12) to display the broadcast signals (paragraph 22, lines 1-7);

means (a modem; paragraph 26, lines 1-9) for the set top box to automatically obtain a connection (paragraph 34, lines 1-3) to the Internet (Fig. 5; paragraph 26, lines 1-8) using a communication module (a modem; paragraph 26, lines 5-8) of the set top box (paragraph 26, lines 5-8) without the user requesting the connection (paragraph 33, lines 6-12 and paragraph 34, lines 1-3), wherein the communication module is different the tuner (Fig. 1; paragraph 22).

While Nakano discloses means for receiving information from the Internet (a modem for home shopping; paragraph 31, 36 and 37), he fails to specifically disclose receiving a subscriber renewal notice over the connection to the Internet.

In an analogous art, Hunter discloses a video distribution system (Fig. 4; paragraph 12) wherein a user will receive broadcast video for display on a television

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(paragraphs 65 and 70) and will automatically connect to the Internet through a modem (87, paragraph 51, lines 16-18 and 31-34 and paragraph 67) to receive monthly subscriber renewal notices (monthly renewed security codes to ensure a site is authorized to view the movie; paragraphs 79, 82 and 83) for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display videos (paragraph 79).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Nakano's system to include receiving a subscriber renewal notice over the connection to the Internet, as taught by Hunter, for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display the received content.

As to claims 41, 50 and 59, Nakano and Hunter disclose wherein the subscriber renewal notice is traditionally broadcast via satellite (decryption codes to utilize broadcast video; see Hunter at paragraph 83), the method further comprising receiving broadcast information that utilizes satellite bandwidth no longer consumed by the subscriber renewal notice (see Hunter at paragraphs 51 and 83).

As to claims 42, 51 and 60, Nakano and Hunter disclose wherein the subscriber renewal notice comprises service provider facility data that is used by the set top box on a monthly basis (used to access the video; see Hunter at paragraphs 79 and 83).

As to claims 43, 52 and 61, Nakano and Hunter disclose establishing a secure electronic connection (see Nakano at paragraph 34, lines 1-9) with a server (see Nakano at column 30, lines 1-5) through the connection to the Internet (see Nakano at paragraph 26, lines 1-9), wherein the subscriber renewal notice is received through the secure electronic connection (see Hunter at paragraph 83).

As to claims 48, 57 and 66, while Nakano and Hunter disclose wherein the automatically obtaining a connection comprises:

if an Internet connection is currently established (to allow transmission over the Internet; see Nakano at paragraph 32), automatically (see Nakano at paragraph 32, lines 4-7) obtaining a new transmission protocol/internet protocol (TCP/IP) connection (wherein an Internet connection is in TCP/IP protocol; see Nakano at paragraph 32) through the communication module using the established Internet connection (see Nakano at paragraph 26, lines 5-12), he fails to specifically disclose determining if an Internet connection is currently established.

The examiner takes Official Notice that it is notoriously well known in the art to include means to determine if a system currently has an established Internet connection for the typical benefit of avoiding failed data transmissions due to a lack of an Internet connection.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Nakano and Hunter's system to include determining if an Internet

connection is currently established for the typical benefit of avoiding failed attempts to conduct a shopping transaction due to a lack of an Internet connection.

3. Claims 46, 47, 55, 56, 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano and Hunter as applied to claims 40, 49 and 58 above, and further in view of Hayward et al. (Hayward) (US2003/0023703) (of record).

As to claims 46, 55 and 64, while Nakano and Hunter disclose the set top box automatically connecting to a computer (DB2; see Nakano at paragraph 30, lines 1-5), without the user requesting a connection (the set top automatically makes a connection when the card is entered; see Nakano at paragraph 34, lines 1-3), using the communications module (a modem connecting through telephone lines to the Internet; see Nakano at paragraph 26; lines 5-14), wherein the communications module is a modem (see Nakano at paragraph 26, lines 5-14), they fail to specifically disclose receiving a local phone number, dialing the local phone number and establishing a connection to the Internet through a computer that answers the dialed local phone number.

In an analogous art, Hayward discloses a computer system (Fig. 2) wherein a local telephone number provided to the user system (paragraph 20, lines 10-12) is dialed to make a connection (to the POP; paragraph 20, lines 6-15) using a modem (34) to establish a connection to the Internet through a computer (the POP connecting to the Internet backbone; paragraph 20, lines 4-21) that answers the dialed phone number

(paragraph 20, lines 4-8) for the typical benefit of providing a means for a user to connect to the Internet through their phone line (paragraph 20, lines 1-8).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Nakano and Hunter's system to include receiving a local phone number, dialing the local phone number and establishing a connection to the Internet through a computer that answers the dialed local phone number, as taught by Hayward, for the typical benefit of allowing a user a simple way to connect to the Internet through a local phone number.

As to claims 47, 56 and 65, Nakano, Hunter and Hayward disclose wherein the local phone number is associated with an Internet service provider (see Hayward at paragraph 20, lines 1-6).

4. Claims 44, 45, 53, 54, 62 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano and Hunter as applied to claims 40, 49 and 58 above, and further in view of Yamamoto et al. (Yamamoto) (6,166,778) (of record).

As to claims 44, 53 and 62, while Nakano and Hunter disclose receiving purchase information (user indication of a good or service to purchase; see Nakano at paragraphs 31, 34 and 35), for a good or service purchased by a user (see Nakano at paragraph 31 and 35), wherein the purchase information was obtained through the user communicating with a set top box (obtained in response to a previous user purchase; see Nakano at paragraphs 31, 34 and 35); and

transmitting the purchase information (see Nakano at paragraph 31, lines 7-13) from the set top box (wherein the connection is made from the set top modem; see Nakano at paragraph 26, lines 5-8) to a server (to server, 46; see Nakano at paragraph 34, lines 6-15) through the connection to the Internet (see Nakano at paragraphs 31-34), they fail to specifically disclose storing the purchase information for the good or service in the set top box.

In an analogous art, Yamamoto discloses a broadcast receiver (Fig. 1) which can perform purchasing (column 37, lines 16-30) wherein user purchase information is stored in the broadcast receiver (charge record information table stored in a IC card; Fig. 43; column 37, lines 48-60) and retrieved for later display to a user (column 37, line 61-column 38, line 13) for the typical benefit of providing a means for a user to easily retrieve and review their purchasing history at a later time (column 38, lines 14-24).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Nakano and Hunter's system to include storing the purchase information for the good or service in the set top box, as taught by Yamamoto, for the typical benefit of providing a means for a user to easily review and verify their purchasing history at a later time.

As to claims 45, 54 and 63, Nakano, Hunter and Yamamoto disclose wherein the purchase information is stored in a smart card (IC card; see Yamamoto at Fig. 43; column 37, lines 48-60).

Response to Arguments

5. Applicant's arguments filed 1/11/06 have been fully considered but they are not persuasive.

a. On page 9, of applicant's response, applicant argues that the downloaded keys of Hunter do not meet the claim limitation of a "subscriber renewal notice".

In response, as indicated in the previous action and the rejections above, Hunter discloses wherein code keys are transmitted **monthly** to a **customer household** at the time of **monthly billing queries** if the customer is **current in payments** (paragraph 82). The monthly transmission of these keys to the customer (i.e. subscriber) based upon the customer's monthly payment (i.e. service renewal) clearly meets the broad claim language of a "subscriber renewal notice".

b. On page 9, of applicant's response, applicant further argues that the code keys of Hunter are not subscriber renewal notices as the keys are for individual movies.

In response, Hunter specifically discloses wherein the subscriber will be provided the proper key for **each** movie, on a monthly basis, if they are current in their payments. As keys for **each** movie are provided to the *subscriber*, based upon the subscriber's *renewal* of the service (bill payment), they clearly qualify as a "subscriber renewal notice". The keys are provided to a particular subscriber

location to allow that particular subscriber to access any of the available movies (paragraphs 82 and 83).

c. On page 10, of applicant's response, applicant argues that Hunter does not disclose that "code key C" is ever transmitted via satellite and further does not suggest the use of the saved bandwidth for broadcast information.

In response, as indicated in the previous action, transmitting decryption keys in the broadcast signal is known and performed in the art. As Hunter transmits his code key C over the phone line, as opposed to the broadcast signal, Hunter thus saves broadcast bandwidth by not utilizing any for these keys. The fact that Hunter may not specifically acknowledge this benefit does not negate the fact that by performing the same function, Hunter inherently takes advantage of any benefit therein.

d. On page 10, of applicant's response, applicant argues that the code key C, transmitted via the phone/modem, do not contain or refer to any "service provider facility data".

In response, as the code keys are "data" provided by the service provider (central controller system, 36; see Fig. 1 and paragraphs 91-94) to allow subscribers to access the movies broadcast by the service provide (paragraphs 83 and 94), they clearly meet the broad claim limitation of "service provider facility data".

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (571) 272-7357. The examiner can normally be reached on 9:00-5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Sheleheda
Patent Examiner
Art Unit 2617

JS


CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600